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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,161	10/23/2003	Lyle J. Clemenson	C338.103.101	8341

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EXAMINER
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KRECK, JOHN J

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/692,161

Applicant(s)

CLEMENSON, LYLE J.

Examiner

John Kreck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-20 is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 3-5, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones (U.S. Patent number 4,554,986).

Jones shows the rotatable cutting tool bit comprising a cylindrical shank (3); bit head (near 4) having a mouth; and cutting tooth (e.g. 31) wherein the axis of the tooth is laterally offset from the axis of the shank as called for in claim 1.

The clip groove as called for in claim 3 is shown above the numeral 1.

The mouth of the bit head shares a common axis with the tooth as called for in claim 4.

With regards to claim 5; the crown and shoulder are shown at 15 and 9.

The axis of the shank is laterally offset from the axis of the mouth as called for in claim 8.

2. Claims 1, 3-8 rejected under 35 U.S.C. 102(b) as being anticipated by Gardner (U.S. Patent number 3,693,736).

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Gardner shows the rotatable cutting tool bit comprising a cylindrical shank (20); bit head (below 21) having a mouth; and cutting tooth (e.g. 29) wherein the axis of the tooth is laterally offset from the axis of the shank as called for in claim 1.

The clip groove as called for in claim 3 is shown in figure 1 between 20 and 21.

The mouth of the bit head shares a common axis with the tooth as called for in claim 4.

With regards to claim 5; the crown (near 7) and shoulder (26, 27) are shown in figure 6.

The axis of the shank is laterally offset from the axis of the shoulder as called for in claim 6.

The axis of the shank is laterally offset from the axis of the crown as called for in claim 7.

The axis of the shank is laterally offset from the axis of the mouth as called for in claim 8.

3. Claims 1, 3-5, 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Tomlinson (U.S. Patent number 4,880,278).

Tomlinson shows the rotatable cutting tool bit comprising a cylindrical shank (12); bit head having a mouth (near 18); and cutting tooth (e.g. 16) wherein the axis of the tooth is laterally offset from the axis of the shank as called for in claim 1.

Tomlinson also shows the groove called for in claim 3.

Tomlinson also shows the common axis(e.g. figure 2) called for in claim 4.

Tomlinson also shows the crown and shoulder called for in claim 5.

Tomlinson also shows the axis of the shank is laterally offset from the axis of the mouth as called for in claim 8.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones.

With regards to claim 2, Jones fails to teach the dimensions; Official Notice is taken of the fact that tools such as shown by Jones are much larger than 0.03 inches; thus at least one of the teeth would be offset by not less than 0.03 inch; alternatively, it would have been obvious to one of ordinary skill in the art at the time of the invention to have offset the tooth axis by not less than 0.03 inch, based on the desired size of the hole to be drilled.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner.

With regards to claim 2, Gardner fails to teach the dimensions; Official Notice is taken of the fact that tools such as shown by Gardner are much larger than 0.03 inches; thus at

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least one of the teeth would be offset by not less than 0.03 inch; alternatively, it would have been obvious to one of ordinary skill in the art at the time of the invention to have offset the tooth axis by not less than 0.03 inch, based on the desired size of the hole to be drilled.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tomlinson. With regards to claim 2, Tomlinson fails to teach the dimensions. It would have been obvious to one of ordinary skill in the art at the time of the invention to have offset the tooth axis by not less than 0.03 inch, since size is largely a matter of engineering design.

7. Claims 9-20 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter: The prior art includes rotatable mining tools, such as shown by EP 1033216 A1; in which the axis of the shank is angularly offset from the axis of the tip. U.S. Patent number 3,841,709 shows a further tool with the axis of the shank angularly offset from the axis of the tip. The Tomlinson reference, cited above, is clearly for a non-rotatable tool; and thus does not disclose or suggest the cutting tooth rotatable relative to the mounting block around an axis which is laterally offset from the longitudinal axis of the cutting tooth.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kreck whose telephone number is (703)308-2725. The examiner can normally be reached on M-F 5:30 am - 2:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703)308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John Kreck  
Examiner  
Art Unit 3673

JJK